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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91164764
Party	Defendant The Brinkmann Corporation
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BRINK'S NETWORK, INCORPORATED,

Opposer,

v.

THE BRINKMANN CORPORATION,

Applicant.

Opposition No. 91164764

**APPLICANT BRINKMANN'S UNCONTESTED MOTION
TO AMEND APPLICATION**

Applicant The Brinkmann Corporation ("Brinkmann"), pursuant to 37 C.F.R. § 2.133, respectfully moves the Board to amend Applicant Brinkmann's subject application in this proceeding, Serial No. 76/483,115, with regard to the dates of first use and first use in commerce. Applicant respectfully submits that the amendment is necessary in order to correctly reflect the dates of first use for the goods remaining in the subject application following the Board's granting of Applicant Brinkmann's motion to divide Applicant's originally filed multi-class application. A declaration in support of this motion is submitted herewith.

Opposer Brink's Network has communicated to Applicant that Opposer will not contest the present motion.

**I.
STATEMENT OF FACTS**

On January 17, 2003, Brinkmann filed the application at issue in this opposition, Serial No. 76/483,115, for its trademark BRINKMANN in multiple classes to cover its then-

existing lines of goods. The original description in International Class 9, the relevant class in this proceeding, was as follows:

Home security systems and components therefor, namely, home security lights, detectors, receivers, transmitters, and adapters; batteries; cooking thermometers; electrical extension cords, brackets, electric connectors, and electric converters; electronic mineral and metal detectors.

The date of first use asserted for International Class 9 was June 12, 1978. Mr. J. Baxter Brinkmann, President of Brinkmann, executed the declaration for the application on November 22, 2002. The application was prepared and submitted by Brinkmann's counsel of record in this proceeding.

During prosecution of the application, the Examining Attorney requested revisions of the recitations of goods in various International Classes and ultimately issued an Examiner's Amendment on July 23, 2004, which contained the following revised description in International Class 9:

Home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets, batteries, wall mount brackets for battery chargers and flashlight, cooking thermometers; electrical extension cords, electric connectors, electric converters; electronic meters and metal detectors, flashlight and spotlight electronic mineral and metal detectors, flashlight and spotlight accessories sold together or separately, namely, transmitters, lighter plugs, filter caps.

The application was published for opposition on October 5, 2004. Opposer Brink's Network filed a Notice of Opposition on April 1, 2005. Opposer objected to registration of BRINKMANN only in connection with certain goods in International Class 9, namely, "Home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets, batteries, wall mount brackets for battery chargers and flashlight, cooking thermometers." Opposer stated in the

Notice of Opposition that Opposer objected to Applicant's "home security systems and components." The grounds for opposition asserted by Brink's Network were (1) likelihood of confusion under section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) with various marks incorporating BRINK'S; (2) dilution under section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), of various marks incorporating BRINK'S; and (3) misuse of the federal registration symbol.

In its Notice of Opposition, Opposer Brink's Network also alleged that the application at issue claimed June 12, 1978 as the date of first use for Applicant Brinkmann's "home security systems and components."

On May 13, 2005, Applicant Brinkmann filed its Answer, in which Brinkmann denied Opposer's allegations, including a denial that the application at issue claims a date of first use of June 12, 1978 with respect to the home security products. Applicant Brinkmann admitted in its Answer that the first use date of June 12, 1978 for International Class 9 is not applicable to the home security products.

On June 1, 2005, Applicant Brinkmann filed an amendment to the application because the Examiner's Amendment of July 23, 2004, rendered the identifications of goods vague and indefinite by failing to (i) separate the different goods through the use of semi-colons instead of commas; (ii) use the plural form instead of singular form for certain goods; (iii) delete redundant descriptions; (iv) correct spelling; and (iv) order the descriptions in a more logical pattern. The amendment sought only to clarify, and not broaden, the identification of goods. Specifically, the amendment corrected, *inter alia*, the identification of home security products so that "batteries, wall mount brackets for battery chargers and flashlight [sic], cooking thermometers" were not included as part of the recitation of goods for "home security systems

and components.”

On June 16, 2005, Opposer filed a response clarifying that the Notice of Opposition was only directed to “Home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets,” and not to “batteries, wall mount brackets for battery chargers and flashlight [sic], cooking thermometers.” The Board approved the amendment on June 28, 2005.

Opposer Brink’s Network served its First Set of Interrogatories on September 6, 2005. Interrogatory No. 3 requested Applicant to state Applicant’s date of first use and date of first use in commerce of the mark BRINKMANN in connection with “home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets.”

Applicant Brinkmann served responses to the First Set of Interrogatories on October 11, 2005, in which Applicant stated that the date of first use for the “home security products” was at least as early as October 1989.

Applicant Brinkmann served amended and supplemental responses to the First Set of Interrogatories on February 15, 2007, in which Applicant’s response to Interrogatory No. 3 remained unchanged.

Opposer Brink’s Network filed its Motion for Leave to file an Amended Notice of Opposition on April 30, 2009. In the proposed First Amended Notice of Opposition, Brink’s Network sought to add a “fraudulent representation of material fact” as a ground for opposition, citing an alleged failure to comply with the Trademark Manual of Examining Procedure (“TMEP”) § 903.09, which provides in part that “[w]here the dates of use do not pertain to all items, the applicant should designate the particular item(s) to which they do pertain.” In other

words, Opposer Brink's Network alleged that Brinkmann should have specified in its application the different date of first use (October 1989) for its home security products.

Opposer Brink's Network's proposed First Amended Notice of Opposition deleted Opposer's claim of ownership of Reg. No. 2,476,114 because that registration was cancelled under section 8 of the Trademark Act, subsequent to the filing of the original Notice of Opposition.

Opposer Brink's Network filed a second motion, entitled Motion for Leave to File Second Amended Notice of Opposition, on May 13, 2009, in which Opposer requested leave to substitute a second Amended Notice of Opposition for the First Amended Notice of Opposition submitted with its motion on April 30, 2009. Opposer's asserted reason for filing the motion for leave to substitute was that the Second Amended Notice of Opposition deleted ownership of Reg. Nos. 2,691,470 and 2,646,784, in anticipation of their cancellation under section 8 of the Trademark Act. Opposer Brink's Network requested the Board to decide both of its motions concurrently.

On August 7, 2009, the Board, deciding both of Opposer's motions concurrently, granted Opposer's motion for leave to file its Second Amended Notice of Opposition to delete the three relevant registrations, but struck Opposer's fraud claim from the notice of opposition because the Board found that the claim was legally insufficient and futile.

On August 27, 2009, Applicant Brinkmann filed a motion to divide Applicant's application into two applications, namely (i) a child application containing the goods in International Classes 4, 6, 7, 8, 11, 12, 21, 30 and the unopposed goods in International Class 9; and (ii) a parent application containing the opposed home security products in International Class 9. The Board granted the motion to divide on September 16, 2009, and suspended

proceedings while the application was referred to the U.S. Patent and Trademark Office's intent-to-use unit for processing of the division into parent and child applications.

Although a notice of divided application was mailed out by the intent-to-use unit on November 10, 2009, the child application, Serial No. 76/979,024, containing the unopposed goods, was not registered until June 8, 2010, as Registration No. 3,797,964.

On June 4, 2010, Opposer filed a motion for leave to file a third amended Notice of Opposition to assert three additional trademark registrations. That motion is currently pending before the Board.

On July 16, 2010, Opposer Brink's Network filed a motion to extend the testimony periods, stating that Opposer should not have to commence its testimony period without knowing whether or not the third amended notice of opposition will be accepted by the Board. That motion is also currently pending before the Board.

In a recent status check of the opposed parent application on the U.S. Patent and Trademark Office TESS database, Applicant Brinkmann realized that the application at issue in this proceeding still identifies June 12, 1978 for the remaining and opposed goods in International Class 9, although that date applied to goods in the class that have been divided out into Registration No. 3,797,964. Accordingly, Applicant Brinkmann files the present motion to correct the dates of first use.

II.

DISCUSSION

A. Proposed Amendment

Applicant Brinkmann respectfully requests that the Board amend application Serial No. 76/483,115 to amend the dates of first use anywhere and in commerce from June 12,

1978 to at least as early as October 1989. A declaration under 37 C.F.R. § 2.20 in support of the amended dates of first use, along with specimen of use, is attached hereto.

B. Applicant Brinkmann's Proposed Amendment is Necessary in Order to Correct the Dates of First Use Asserted in the Application

Applicant Brinkmann's proposed amendment to amend the dates of first use is necessary now that Applicant's motion to divide its application has been granted. When Applicant filed its application on January 17, 2003, Applicant's recitation of goods in International Class 9 contained a multitude of goods, but with one asserted date of first use anywhere and one asserted date of first use in commerce. This is customary practice before the U.S. Patent and Trademark Office:

903.09 More than One Item of Goods or Services

If more than one item of goods or services is specified in a particular class, the date of first use anywhere and date of first use in commerce do not have to pertain to every item in the class. It might be that the mark, although in use on all of the items at the time the application or allegation of use was filed, was first used on various items on differing dates, so that it would be cumbersome to designate the dates for all items individually. . . . Where the dates of use do not pertain to every item in the class, and the identification of goods or services is amended to delete the item(s) to which the dates of use pertain, the applicant must amend the dates-of-use clause to specify the dates that apply to an item that remains in the identification, and this item should be designated.

See TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 903.09.

Opposer Brink's Network only opposed the "home security products" in International Class 9 in Applicant's application Serial No. 76/483,115. The unopposed goods in International Class 9 were divided out under child application Serial No. 76/979,024. The June 12, 1978 dates of first use applied to goods in the child application. The present opposed parent application Serial No. 76/483,115 still recites the June 12, 1978 dates of first use,

although those dates are not correct for the remaining goods in the application, namely, Applicant's home security products.

C. Applicant's Proposed Amendment Complies with Applicable Trademark Rules

Applicant Brinkmann's proposed amendment to its application complies with the applicable Trademark Rule 2.71, which states in relevant part as follows:

The applicant may amend the dates of use, provided that the applicant supports the amendment with an affidavit or declaration under § 2.20, except that the following amendments are not permitted: (1) In an application under section 1(a) of the Act, the applicant may not amend the application to specify a date of use that is subsequent to the filing date of the application...

37 C.F.R. § 2.71(c); *see also* TMEP § 514.01.

Applicant Brinkmann's proposed amendment to amend the dates of first use from June 12, 1978 to October 1989 complies with 37 C.F.R. § 2.71(c). The application was filed on January 17, 2003 and the corrected date of October 1989 is prior in time, and not subsequent to, the filing date of the application.

Applicant Brinkmann respectfully submits that this motion is timely filed – before the opening of testimony periods – and no prejudice to Opposer Brink's Network is present.

D. Opposer Brink's Network Will Not Contest the Amendment

Counsel for Applicant Brinkmann contacted counsel for Opposer Brink's Network by e-mail on August 10, 2010 to ascertain whether Opposer consented to the present motion. Opposer Brink's Network informed counsel for Applicant Brinkmann via e-mail on August 11, 2010 stating that Opposer will not contest the motion.

III.
CONCLUSION

For all the reasons stated herein, Applicant Brinkmann respectfully requests that the Board grant Applicant Brinkmann's motion to amend the application.

Dated: August 26, 2010



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Attorneys for Applicant
THE BRINKMANN CORPORATION

CERTIFICATE OF SERVICE

This is to certify that I have this day, August 26, 2010, caused to be served a copy of the foregoing "Applicant Brinkmann's Motion to Amend Application" by placing a copy in the United States Mail, postage pre-paid, addressed as follows: Alan S. Cooper, counsel for Opposer, at Howrey LLP, 1299 Pennsylvania Avenue, N.W., Washington, DC 20004.



Susan Hwang

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BRINK'S NETWORK, INCORPORATED,

Opposer,

v.

THE BRINKMANN CORPORATION,

Applicant.

Opposition No. 91164764

Serial No. 76/483,115

Mark: BRINKMANN

Filing Date: January 17, 2003

Class: 9

**DECLARATION IN SUPPORT OF APPLICANT BRINKMANN'S
MOTION TO AMEND APPLICATION**

The undersigned hereby declares that, upon information and belief, Applicant first used the mark on or in connection with all of the goods in International Class 9 set forth in the application, namely, "Home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets," at least as early as October 1989; and first used the mark in commerce on or in connection with all of the goods in International Class 9 set forth in the application, namely, "Home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets," at least as early as October 1989. One specimen showing use of the mark in connection with the goods recited in the application is submitted herewith.

The undersigned further declares: that the undersigned declarant is authorized to make this Declaration on behalf of Applicant; that declarant believes Applicant to be the owner of the mark of this application; that the mark of this application is in use in interstate commerce; and that all statements made herein of declarant's own knowledge are true; that all statements made herein on information and belief are believed to be true; and further, that these statements

were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application and any registration resulting therefrom.

Date: August 26, 2010

By: 
J. BAXTER BRINKMANN